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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Juarez, Jorge Ancheyta et al.	:	Art Unit: 1797
	:	
Patent No.: 7,651,604	:	Examiner: B. McCaig
	:	
Issue Date: January 26, 2010	:	Confirmation No.: 3745
	:	
Serial No.: 10/563,577	:	
	:	
Filed: June 21, 2006	:	
	:	
For: Process For The Catalytic	:	
Hydrotreatment Of Heavy	:	
Hydrocarbons Of Petroleum	:	

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b) and (d)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the terms of 37 C.F.R. § 1.705(b) and (d), Applicants respectfully request reconsideration of the patent term adjustment indicated in the Letters Patent issued on January 26, 2010. For the reasons provided below, the Applicant is entitled to this request since the issued patent should have indicated a revised patent term adjustment from that set forth in the notice of allowance mailed on August 27, 2009.

Pursuant to 37 C.F.R. § 1.705(d), Applicants are filing this request, which meets the requirements under 37 C.F.R. § 1.705(b)(1) and (b)(2), within two months of the issue date of the patent in the above identified application.

The fee set forth in 37 C.F.R. § 1.18(e) is submitted herewith as required under 37 C.F.R. § 1.705(b)(1).

Applicants provide the following statements of the facts as required under 37 C.F.R. § 1.705(b)(2).

Correct Patent Term Adjustment and the Basis Therefore

Applicants believe that the correct patent term adjustment (PTA) for the present application to be **388 days**, rather than 286 days as indicated in the issued patent. Support for Applicants' position is set forth in the decision by the Court of Appeals for the Federal Circuit in *Wyeth v. Kappos*, No. 2009-1120, dated January 7, 2010. The basis for Applicants' position is that the U.S. Patent and Trademark Office incorrectly interpreted the law governing patent term adjustments under 35 U.S.C. § 154(b)(1)(A)-(C), and specifically, the provision in 35 U.S.C. § 154(b)(2)(A) which states "[t]o the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed." The periods of delay specified in paragraph (1) that are relevant in this application are the delay due to the failure of the U.S Patent and Trademark Office to provide at least one of the notifications under section 35 U.S.C. § 132 not later than 14 months after the date on which the application was filed (period "A"), and the delay due to the failure of the U.S. Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States (period "B"). Thus, as stated in the decision by the Court of Appeals for the Federal Circuit in *Wyeth v. Kappos*, No. 2009-1120, dated January 7, 2010, the PTA calculation should be the addition of the

terms of period “A” and period “B” (minus the number of days of Applicant delay and any actual overlap in the days of period “A” and period “B”), and not the greater of the two periods as the U.S. Patent and Trademark Office has previously calculated.

In view of the above decision by the Court of Appeals for the Federal Circuit on January 7, 2010, any patent issuing after this date should have indicated a corrected patent term adjustment in line with the Court’s interpretation of the relevant statute. Prior to submitting payment of the issue fee, Applicants could not have known that the U.S. Patent and Trademark Office would change its interpretation and application of the rules for calculating patent term adjustment. Thus, the issues raised in this request could not have been raised prior to submitting payment of the issue fee in this application. Specifically, the issued patent should have included a revised patent term adjustment, from that indicated in the notice of allowance, to include the additional “B” delay that occurred during prosecution of the application, a period of delay that the Applicants could not have known they were additionally entitled to at the time of submitting payment of the issue fee, in view of the U.S. Patent and Trademark’s policy for calculating patent term adjustment. Therefore, under 37 C.F.R. § 1.705(d) the Applicant is entitled to this request for a corrected patent term adjustment.

Relevant Dates as Specified in 37 C.F.R. §1.703(a)-(e)

- 1) Filing date of the application under 35 U.S.C. § 371(c): June 21, 2006
- 2) Mailing date of first Office Action (Non-Final Rejection): September 4, 2008 (14 months + 380 days after the filing date of the application)
- 4) Date three years from the filing date: June 21, 2009

- 3) Date of Applicant request for continued examination: October 1, 2009 (3 years + 102 days after the filing date of the application)
- 4) Date of issuance of the patent: January 26, 2010

Given the dates set forth above, the number of days of patent term adjustment falling within period “A”, that is, the period set forth in 35 U.S.C. § 154(b)(1)(A), is 380 days which is calculated as follows: the date on which the first office action issued was 14 months + 380 days after the filing date of this application.

Given the dates set forth above, the number of days of patent term adjustment falling within period “B”, that is, the period set forth in 35 U.S.C. § 154(b)(1)(B)(i), is 102 days which is calculated as follows: the period running from the three year anniversary of the filing date of the application to the date on which the Applicant requested continued examination under 35 U.S.C. § 132(b).

The delay in period “A” did not extend more than 3 years from the filing date of this application, thus there is no overlap into period “B”. Since there is no overlap, the actual number of days of delay in the issuance of the patent specified in 37 C.F.R. § 1.703(a)-(e) is 482 days (380 + 102).

Circumstances as Set Forth in 37 C.F.R. § 1.704

- 1) Applicant’s filing of Response to Non-Final Rejection: January 5, 2009 (3 months + 2 days after the mailing date of the supplemental Office Action mailed on October 3, 2008)

- 2) Date of Applicant request for continued examination: October 1, 2009: (3 months + 92 days after the mailing date of a Final Rejection on April 1, 2009)

Given the dates set forth above, under 37 C.F.R. § 1.704 (b), the period of time attributable to the Applicant for failing to conclude prosecution is 94 days (2 + 92).

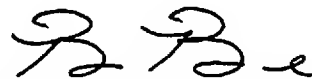
Terminal Disclaimer

This patent application is not subject to a terminal disclaimer.

Conclusion

Based on the facts set forth above and the calculations provided for determining the periods of delay under 37 C.F.R. § 1.703(a)-(e) and 37 C.F.R. § 1.704, the Applicant is entitled to a patent term adjustment of 388 days (482-94). In view of the above, Applicants respectfully request favorable reconsideration of the patent term adjustment indicated in the Letters Patent issued on January 26, 2010, and a notice to that effect.

Respectfully submitted,



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